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EXAMINER

GURSHMAN, GRIGORY

ART UNIT PAPER NUMBER

2132

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,035

Applicant(s)

GIEN ET AL.

Examiner

Grigory Gurshman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant has filed no amendment to the claims.
2. Referring to claims 1-40, Applicant argues Godfrey fails to disclose the features of claim 1, because he fails to teach that a web application is transmitted from unit 106 to unit 104. Examiner respectfully disagrees and point out that Fig.1 of Godfrey clearly depicts an application web server (106), which transmits the application to the client (104) running the browser. Examiner maintains his position that despite the alleged technical differences between Applicant' invention and Godfrey, all of the limitations of the claims 1-40, taking the independent claims 1 and 21 as an example, are met by Godfrey as fallows:

the limitation "a browser; a signing module; and a signing interface" is met by unit 1 (104 in Fig. 1) comprising a web browser and unit 108 (in Fig.1) comprising digital signature generator (118) and an interface in a form of digital signature initiation data detector(116). The limitation "the signing interface to be invoked by a Web application transmitted to the browser from the remote location" is met by application transmitted from the remote web server (unit 106 in Fig.1). The limitation "forwarding data to be signed by the signing module" is met by unit 108 (link 124), which illustrates forwarding data to digital signature generator. The limitation "receiving at the signing interface a digital signature for data to be signed from the signing module" is met by receiving the data at unit 116 from unit 120. The limitation "forwarding the digital signature to a

remote location specified by the Web application” is met by sending the generated signed transaction form proxy 110 (i.e. remote location) in step 128 – see Fig. 1.

3. Referring to claims 41-45 , Applicant argues that Godfrey does not teach the limitations of claim 41. Examiner respectfully disagrees and points out that limitations of claim 41 are met by Godfrey :

the limitation “a browser; a signing module; and a signing interface” is met by unit 1 (104 in Fig. 1) comprising a web browser and unit 108 (in Fig.1), comprising digital signature generator (118) and an interface in a form of digital signature initiation data detector (116). Referring to claim 41, the limitation “the signing interface being adopted to facilitate access to system services provided via a four-corner model” is met by unit 116 (in Fig.1). The limitation “means for downloading a Web application..” is met by proxy (unit 108 in Fig. 1).

4. In view of the reason presented herein rejections of claims 1-48 are maintained.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Godfrey (U.S. Patent No. 6.363.479 B1).

7. Referring to the instant claims, Godfrey discloses a system and method for signing markup language data (see abstract). Referring to the instant claims, Godfrey teaches an apparatus, which facilitates digital signing of data communicated between a first unit and a second unit through an interface independent proxy, or multiple independent proxies, interposed between the first and second units. The independent proxy has a digital signature initiation data detector to detect embedded signature initiation data in data to be signed. The independent proxy contains a signature generator through which the form based communication data flows. Initiation data is used in the communication data to automatically trigger the intermediary or independent proxy to sign the communication data (see abstract and Fig.1).

8. Referring to the independent claims 1 and 21, the limitation "a browser; a signing module; and a signing interface" is met by unit 1 (104 in Fig. 1) comprising a web browser and unit 108 (in Fig.1) comprising digital signature generator (118) and an interface in a form of digital signature initiation data detector(116). The limitation "the signing interface to be invoked by a Web application transmitted to the browser from the remote location" is met by application transmitted from the remote web server (unit 106 in Fig.1). The limitation "forwarding data to be signed by the signing module" is met by unit 108 (link 124), which illustrates forwarding data to digital signature generator. The limitation "receiving at the signing interface a digital signature for data to be signed from the signing module" is met by receiving the data at unit 116 from unit 120. The limitation "forwarding the digital signature to a remote location specified by the Web

application" is met by sending the generated signed transaction form proxy 110 (i.e. remote location) in step 128 – see Fig. 1.

9. Referring to claims 5-7 and 25-27, Godfrey teaches the use of signature as mark up language tags (see block 414 in Fig.4).

10. Referring to claims 8 and 28, Godfrey teaches that data to be signed is retrieved from a remote location (see units 112 and 114 in Fig.1).

11. Referring to claims 9 and 29, Godfrey teaches that data to be signed is included in the Web application (see units 104 and 108 in Fig.1).

12. Referring to claims 1 and 30, it is inherent to digitally sign data with the key.

13. Referring to claim 16, it is inherent to have a signing interface comprising the user interface part.

14. Referring to claim 22, it is inherent to a set of APIs within an applet referenced in a Web page.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 41- 45, are rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey (U.S. Patent No. 6,363,479 B1) in view of Gibbs (U.S. Patent No. 6,085,321).

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Referring to the instant claims, Godfrey discloses a system and method for signing markup language data (see abstract). Referring to the instant claims, Godfrey teaches an apparatus, which facilitates digital signing of data communicated between a first unit and a second unit through an interface independent proxy, or multiple independent proxies, interposed between the first and second units. The independent proxy has a digital signature initiation data detector to detect embedded signature initiation data in data to be signed. The independent proxy contains a signature generator through which the form based communication data flows. Initiation data is used in the communication data to automatically trigger the intermediary or independent proxy to sign the communication data (see abstract and Fig.1).

17. Referring to the independent claims 41 and 45, the limitation "a browser; a signing module; and a signing interface" is met by unit 1 (104 in Fig. 1) comprising a web browser and unit 108 (in Fig.1), comprising digital signature generator (118) and an interface in a form of digital signature initiation data detector (116).

Referring to claim 41, the limitation "the signing interface being adopted to facilitate access to system services provided via a four-corner model" is met by unit 116 (in Fig.1). The limitation "means for downloading a Web application.." is met by proxy (unit 108 in Fig. 1). The limitation "a first participant, a second participant" is met by unit 1 and unit 2 (see Fig.1, 104 and 106). The limitation "forwarding data to be signed by the signing module" is met by unit 108 (link 124), which illustrates forwarding data to digital signature generator. The limitation "receiving at the signing interface a digital signature for data to be signed from the signing module" is met by receiving the data at unit 116

from unit 120. The limitation "forwarding the digital signature to a remote location specified by the Web application" is met by sending the generated signed transaction form proxy 110 (i.e. remote location) in step 128 - see Fig. 1. While Godfrey teaches forwarding the data to be signed to the signing module, he does not explicitly teach that the data is forwarded to the signing module after receiving a response to a service request. Referring to the instant claims, Gibbs discloses a unique digital signature (see title and Fig.1) used for the WWW transactions (see Fig.4). Gibbs teaches that the service id 104 is tested to verify that it represents a valid local username or service name. If the service id 104 is not valid, then the request for service is rejected. If the service id 104 is valid, then processing continues and data is signed (see Fig.1 and column 8, lines 50-55). Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify the signing system of Godfrey, which forwards the data to be signed to the signing module, by adding the means for verification of service request prior to signing the data as taught in Gibbs. One of ordinary skill in the art would have been motivated to modify the signing system, which forwards the data to be signed to the signing module, by adding the means for verification of service request prior to signing the data as taught in Gibbs for creating a unique digital signature which includes service id (see Gibbs abstract and Fig.1).

18. Referring to claims 43, 44, 47, 48 it is well known in the art of internet transactions to provide warranty in response to a service request. For example buyers on line request product warranty, which is transmitted in digitally signed form. One of

ordinary skill in the art would have been motivated to send the product warranty in the digital form for online transactions.

19. Claims 11, 12, 31 and 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey (U.S. Patent No. 6,363,479 B1) in view of Dancs (U.S. Patent No. 6,385,651).

20. Referring to the instant claims, Godfrey discloses a system and method for signing markup language data (see abstract). Referring to the instant claims, Godfrey teaches an apparatus, which facilitates digital signing of data communicated between a first unit and a second unit through an interface independent proxy, or multiple independent proxies, interposed between the first and second units (see abstract and Fig. 1). Godfrey however does not explicitly teach that digitally signed data includes smart card and signature security data. Referring to the instant claims, Dancs shows a smart card internet system (see Fig. 1). Dancs teaches that all data on the smart card 102 is written including the digital signature of the author of the data. Therefore at the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify the signing system of Godfrey, which forwards the data to be signed to the signing module by having digitally signed data including smart card security data as taught in Dancs. One of ordinary skill in the art would have been motivated to modify the signing system, which forwards the data to be signed to the signing module, by having digitally signed data including smart card security data as taught in Dancs for verification of data integrity.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grigory Gurshman whose telephone number is (571)272-3803. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571)272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GG

Grigory Gurshman
Examiner
Art Unit 2132



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